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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,779	07/27/2001	Ronald J. Skrzyniarz	1945.BDM	8792

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EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 09/916,779	<b>Applicant(s)</b> SKRZYNIARZ ET AL.	
	<b>Examiner</b> Victor S Chang	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the appeal brief filed on 3/17/2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The Examiner has carefully considered Applicants' amendments and remarks filed on 3/17/2004. Applicants' amendments to claims 12, 17 and 21 have been entered. In response to Applicants' statement that "the examiner renewed a rejection of claim 13 as being indefinite ... it is unclear if this rejection formed the basis of the examiner's refusal to enter the amendment", the Examiner notes that the proposed amendments were not entered in the Advisory action (Paper No. 120903) because the claims are not compliant with the revised 37 CFR 1.121.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Rejections not maintained are withdrawn.

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5. This application contains claims 19 and 20 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Response to Amendment***

6. Claims 12-18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (US 4036673), substantially for the reasons set forth in sections 5 and 6 of Paper No. 5, together with the following additional observations.

Murphy's invention is directed to installing (bonding) a sheet of surface covering material on a substrate surface by a foamed adhesive (column 1, lines 7-12). Murphy teaches that it is known art to install (bond) a surface covering material on a surface such as a floor surface, wall surface, countertop, etc. (column 1, lines 16-18).

Particularly suitable adhesives including polyvinyl acetate latex, etc. may be used to form the foamed adhesive (column 3, lines 51-68).

For claims 12 and 18, although Murphy teaches floor covering as a typical example for bonding a sheet of surface covering material on a substrate surface (column 3, lines 20-21), clearly Murphy's teaching of installing a sheet of surface covering encompasses the making of countertop (analogous art) as set forth above. Note also as evidence by the state of the art Karszes, which teaches that it is known art that polyvinyl acetate is a suitable adhesive for bonding high pressure laminates to a substrate such as plywood, particle board, chipboard, etc., to make countertop, flooring, etc. (US 3891788, column 2, lines 15-27). As such, it would have been obvious to one

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of ordinary skill in the art to make a countertop by bonding a high pressure laminate to a substrate such as particle board by the use of a foamed adhesive, as taught by Murphy, motivated by the desire to obtain an improved bonded article, such as a smooth even finished surface (column 3, lines 33-50).

For claim 13, although Murphy is silent about the foamed volume, it is noted that Murphy teaches substantially the same scope of subject matter, i.e., bonding a surface covering to a substrate by using a foamed adhesive. As such, a suitable foamed volume is believed to be either implicitly disclosed, or an obvious optimization to one skilled in the art, motivated by the desire to obtain a suitable foamed adhesive. Further, the Examiner notes that the foamed volume is clearly a process limitation, as evidenced by Murphy's teaching that the purpose of foaming the adhesive is to modify the adhesive, so as the adhesive "does not tend to flow as a liquid, but does spread readily under the pressure of the surface covering material applied to it" (column 3, lines 46-50), and "the adhesive spreads when the sheet material is applied so as to almost completely eliminate any voids in the adhesive layer" (column 5, lines 64-66). It should be noted that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

For claim 14, Murphy expressly teaches that polyvinyl acetate homopolymers and copolymers may be used as the adhesive component of the composition (column 3,

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lines 54-60), which clearly inherently encompasses the blend of at least two polyvinyl acetates of different molecular weights.

For claims 15-16, Murphy teaches that the presence of a filler in the adhesive composition gives the composition sufficient body so as to prevent running of the adhesive as well as provide support for the surface covering. Further, the Examiner notes that it is well known art that starch (polysaccharide) filler has been used to formulate foamed polyvinyl acetate adhesive, as evidenced by the state of the art of Mudge (US 4692366) which teaches that "up to 50 percent acetylated, casein, hydroxyethyl starch, carboxymethyl cellulose, gum arabic, and the like, are known in the art of synthetic emulsion polymer technology" (column 4, lines 1-5).

For claim 17, in Example 1, Murphy discloses that additive such as a defoaming agent is included in the adhesive composition (column 4, line 40).

With respect to the product-by-process claim 21, the Examiner notes that the method limitations of preparing polyvinyl acetate by "batch polymerization" and "continuous polymerization" have not been shown on the record to produce a patentably distinct article. It is the Examiner's position that clearly the polymerization processes have not been shown to produce materially different polyvinyl acetates, as such the formed articles are rendered *prima facie* obvious. Further, the Examiner notes that Murphy's teaching also clearly reads on polyvinyl acetates made by either polymerization process, and it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose (adhesive), in order to form a third composition to be used for the very same purpose. The idea of

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combining them flows logically from their having been individually taught in the prior art.

See MPEP § 2144.06.

For claim 22, although Murphy lacks an express teaching regarding the suitable amounts of polyvinyl acetate and filler, it is noted that Murphy teaches substantially the same scope of subject matter, as set forth above. As such, in the absence of unexpected results, suitable amounts of polyvinyl acetate and filler are also believed to be either implicitly disclosed, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable adhesive composition and adequate adhesion of the surface covering to the substrate, as set forth above.

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**8.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*  
Victor S Chang  
Examiner  
Art Unit 1771

4/27/2004

  
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SUPERVISORY PATENT EXAMINER  
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